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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

Applicant	: Marshall L. Weingarden	Date:	JANUARY 12, 2006
Serial No.	: 10/715,180	Art Unit:	3728
Filed	: November 17, 2003	Examiner:	Bryon P. Gehman
For	: HUB POSTS FOR MOUNTING INFORMATION-BEARING DISKS		Docket No. A-03.71

APPELLANT'S REPLY BRIEF

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

In reply to the EXAMINER'S ANSWER entered in the present appeal on November 15, 2005, appellant offers the following supplemental arguments:

Each of the rejected claims 1 through 21 calls for a combination of structural elements. One of these structural elements is set forth in terms of structure (a hub post constructed of a stiffly resilient material having a specific durometer) and function (providing a balance of resilient characteristics and renitent characteristics for establishing the desired selective gripping and selective release of a disk and for resisting deleterious compression and crushing while retaining the disk upon the post). The prior art is devoid of any disclosure or any suggestion of a combination of elements which includes either the structure or the function provided by that distinguishing structural element.

In his argument with respect to Tillett et al., the Examiner admits that the reference describes a hub post made of a resiliently compressible material which provides a desired **easily** but resiliently compressible nature, yet the Examiner concludes that the hub post of the reference "would" resist deleterious compression and crushing, and that the "inherent durometer" of the material of the hub post "would provide" the distinguishing structural element of the present claimed subject matter, namely, a post constructed of a **stiffly** resilient material having a durometer of a value which provides a balance of resilient characteristics and renitent characteristics for establishing the desired selective gripping and selective release of a disk and for resisting deleterious compression and crushing while retaining the disk upon the post. Thus, despite the clear requirement in the reference for an "easily" resiliently compressible material, the Examiner contends that the material specified in the reference has a durometer which inherently would provide a post constructed of a "stiffly" resilient material for purposes not suggested in the reference.

Likewise, with respect to Fliegel, the Examiner admits that the reference describes a hub post made of a **yielding** material, an example of which is moss rubber, known in the art to be a very soft and highly compliant rubber and described in the reference itself as being relatively soft, yet the Examiner concludes that the hub

post of the reference "would" resist deleterious compression and crushing, and that the "inherent durometer" of the material of the hub post "would provide" the distinguishing structural element of the present claimed subject matter set forth above.

With respect to Attar et al., there is no suggestion in the reference of a hub post having an inherent durometer which provides the characteristics set forth in the present claims, as contended by the Examiner. On the contrary, the reference employs supplemental gripping structures, such as teeth, bumps, horizontal ribs, a lip, vertical ridges or an indentation, and identifies the material for at least one of these supplemental gripping structures as being "sufficiently soft" so as to allow flexure of the supplemental gripping structure. The hub itself can be constructed of a rigid material. The structure suggests nothing which can anticipate or render obvious the subject matter of the present claims.

In the rejections based upon Tillett et al. and Fliegel, the Examiner speculates that the durometer specified in the present claims "may" be inherently met, or "should" be inherently met. It is submitted that such speculation does not meet the Examiner's burden of establishing inherency. The fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. ***In re Rijckaert,*** 28 USPQ2d 1955 (Fed.Cir. 1993),

In re Oelrich, 212 USPQ 323 (CCPA 1981). To establish inherency, evidence must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. ***In re Robertson,*** 49 USPQ2d 1949 (Fed.Cir. 1999), also see MPEP § 2112. In the present instance, the Examiner has not only failed to point out evidence supporting his view of inherency, but has stated conclusions which are entirely counter to the evidence which clearly is present within the references themselves. All of the descriptions in the cited references of the materials employed in the prior art hub posts clearly militate against the Examiner's stated conclusions.

Further, having failed to meet the burden of proving his view of inherency, the Examiner has attempted to shift the burden of proof to appellant, stating that appellant has made negative assumptions about the prior art without factual evidence provided by either the references or appellant. However, the Examiner has failed to establish a prima facie case of anticipation or obviousness, while appellant has pointed out quite specifically where each reference calls for materials which provide characteristics entirely different from those set forth in the present claims. Thus, Tillett et al. calls for an "easily" resilient material, as opposed to the "stiffly" resilient material

set forth in the present claims. Fliegel calls for a "yielding" material, exemplified by the very soft moss rubber, as opposed to the "stiffly" resilient material of the present claims. Attar et al. calls for supplemental gripping structures, such as teeth, bumps, horizontal ribs, a lip, vertical ridges or an indentation, all of which are specifically avoided by the structural combination of elements of the present claims, and identifies the material for at least one of these supplemental gripping structures as being "sufficiently soft" so as to allow flexure of the supplemental gripping structure. The hub itself can be constructed of a rigid material. Accordingly, the Examiner's conclusion that appellant's view of the cited prior art is without factual evidence provided by the references is without merit.

Appellant can agree with the Examiner that resilient structures possess a durometer. However, appellant cannot agree that the prior art hub posts of Tillett et al. and Fliegel both possess an inherent durometer value which provides the characteristics set forth in the present claims. Nor does Attar et al. suggest the specific range of durometer value called for in present claims 5 and 16. In short, all of the present claims set forth a durometer value, in terms of function and in terms of a specific range of durometer value, which is neither anticipated nor rendered obvious in the cited references.

With respect to claims 11 and 12, the Examiner finds that Condorodis discloses a hub post with a surface canted at an angle to facilitate application of a disk to the hub post. While the reference does show a ramped face, the post is not canted. Moreover, the canted post of these claims is for the purpose of deterring inadvertent release of a disk (as made clear in the present specification, at page 10, lines 17 through 23) and is not provided for facilitating the application of a disk. The reference is silent with respect to the canted structure and the purpose of the canted structure. The claimed structure and function are entirely different from the structure and function disclosed in the reference and the rejection based upon the reference cannot be sustained.

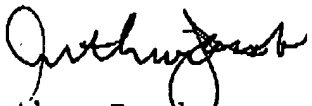
With respect to claims 19 and 21, Cerda-Vilaplana et al. shows a polygonal button (2b), and discloses no polygonal hub post. The polygonal button does not engage a disk, but lies inside a circular array of stems (3) which do engage a disk. There is nothing in the reference which can suggest a polygonal hub post for engaging a disk. The rejection based upon Cerda-Vilaplana et al. must be withdrawn.

CONCLUSIONS

It is respectfully submitted that the rejection of claims 1 through 21, constituting all of the claims in the application, is unwarranted and improper under 35 U.S.C. 102(b) and 35 U.S.C. 103.

In view of the foregoing arguments and authorities, it is respectfully submitted that the Examiner has erred in finally rejecting all of the appealed claims and it is respectfully requested that the rejection of all of the appealed claims be reversed by this Honorable Board.

Respectfully submitted,



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ARTHUR JACOB
NAME OF REGISTERED REPRESENTATIVE

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